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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,128	12/21/2001	John G. Woods	LOCT1100 (028248-3001)	7352

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EXAMINER

ROBERTSON, JEFFREY

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 07/09/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Applicati n No.

10/032,128

Applicant(s)

WOODS ET AL.

Examin r

Jeffrey B. Robertson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 13-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11 and 12 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-12 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that there are an excessive number of groups and that with respect to Groups I and III and Groups II and IV, a search of one group would necessitate a search of the other group. This is not found persuasive because a search of Groups III and IV is not necessary for Groups I and II. Groups I and II are directed to organic compounds that have a different classification than adhesive compositions. As stated in paragraphs 3 and 9 of the restriction requirement, these organic compounds have separate utility other than those set forth by applicant, and therefore a search of adhesive compositions is not necessary for the compounds of Groups I and II.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

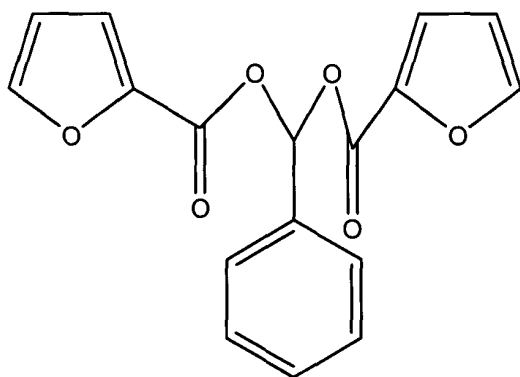
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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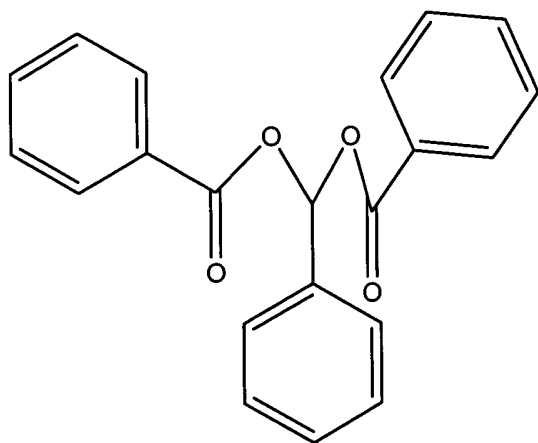
3. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Minami et al. (U.S. Patent No. 3,293,220).

For this rejection, it is noted that the terms "ethylenic unsaturation" and "cycloalkenyl" have been interpreted to include aromatic structures.

For claim 1, in column 3, lines 7-29, Minami teaches that gem-diesters can be synthesized through the reaction of an aldehyde with carboxylic acid anhydride. In columns 7 and 8, lines 6-26, Minami sets forth Table 3 containing products such as benzylidenedifuroate (Ex. 23), the structure of which is:



For claims 2 and 3, this compound falls within applicant's formula where L is aryl and falls within the definition set forth in claims 4, 5, and 7, where Y is not present and  $m=0$ . Here there are 7 units of ethylenic unsaturation. For claims 6 and 8, also in Table 3, Minami sets forth benzylidenedibenzoate:

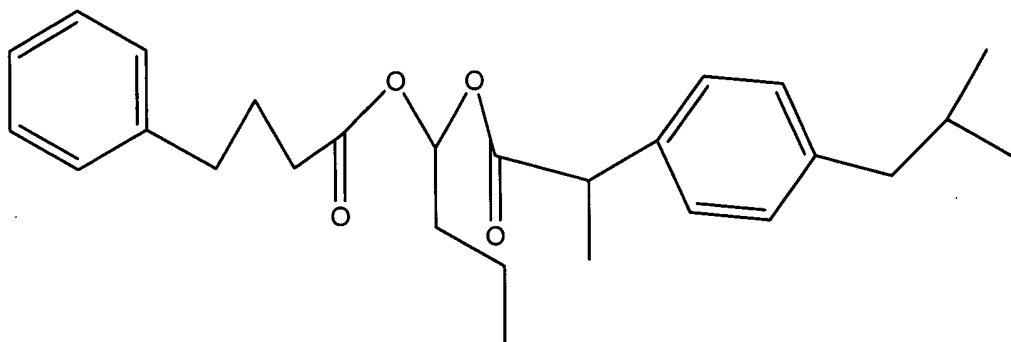


where both R's equal cycloalkenyl. Note here that there are 9 units of ethylenic unsaturation.

4. Claims 1, 2, 11, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Nudelman et al. (U.S. Patent No. 6,110,955).

For this rejection, it is noted that the term "ethylenic unsaturation" has been interpreted to include aromatic structures.

For claims 1, 2, 11, and 12, in columns 18-20, in Table 1, Nudelman teaches structures that conform to the formula set forth by applicant. In Table 1, structure 7 corresponds to the following structure:



For claims 2, 11, and 12, in this structure, applicant's  $L=C_3H_7$ . Note there are six units of ethylenic unsaturation.

5. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Seo et al. (U.S. Patent No. 6,313,327).

For claim 1, Seo teaches in column 5, lines 10-25 in Example 4, a compound that falls within applicant's definition. Note that here there are two units of non-aromatic ethylenic unsaturation. Here, L=heteroatom-containing hydrocarbonyl.

***Allowable Subject Matter***

6. Claims 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. For claims 9 and 10, Minami, Nudelman, and Seo are the closest prior art. None of these references teach or suggest situations where  $n=2$  in applicant's formula.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Spivey et al. (U.S. Patent No. 5,710,328), Tustin et al. (U.S. Patent No. 5,744,637), and Sanderson (EP 0125781 A1) are cited for general interest.

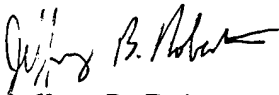
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (703) 306-5929. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on (703) 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Jeffrey B. Robertson  
Primary Examiner  
Art Unit 1712

JBR  
July 7, 2003